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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,624

07/16/2003

Hidetoshi Katayanagi

01601C/LH

1855

1933

7590

06/25/2004

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
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NEW YORK, NY 10017-2023

EXAMINER

BEATTY, ROBERT B

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/621,624

Applicant(s)

KATAYANAGI ET AL.

Examiner

Robert Beatty

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2852

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 11-19, 22-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 6 of U.S. Patent No. 6,603,932 in view of Kawabata et al.

U.S. '932 teach an image forming apparatus comprising a photoconductive member, a developing unit for developing an electrostatic image on the photoconductor with toner, an intermediate transfer member in contact with the photoconductor, a first transfer section for transferring the developed image from the photoconductor to the intermediate transfer member, a second transfer section for transferring the image from the intermediate transfer member to a transfer material, a first cleaning unit for cleaning the toner on the photoconductive member, a second cleaning member for cleaning toner remaining on the intermediate transfer member, a fixing unit for fixing the transferred toner image

to the transfer material, and a controller to control a process of the image forming apparatus for 1) when the image forming apparatus stops for stopping the rotation of the intermediate transfer member after transferring an image formed in the non-image area of the photoconductor to the intermediate transfer member and after cleaning the toner image on the intermediate transfer member and 2) when the image forming apparatus stops for stopping the rotation of the photoconductor after controlling at least one of the transfer voltage and transfer current of the transfer section so that a majority of the toner of the toner image in the non-image area of the photoconductor remains on the photoconductor and after cleaning the toner image remaining on the photoconductor.

Specifically, U.S. '932 teach everything claimed except the development process being a reverse development process, the first and second transfer members being transfer rollers, the first and second cleaning units being cleaning blades. Kawabata et al. teach an image forming apparatus comprising a photoconductive member, an intermediate member, a first transfer roller 18 (see Fig.2) for transferring a developed toner image from the photoconductor to the intermediate transfer member, a second transfer roller 25 for transferring a developed image from the intermediate transfer member to a transfer material, a first cleaning blade 19 for cleaning residual toner off the photoconductive member, and a second cleaning blade 41 for cleaning residual toner off the intermediate transfer member. The development process is reverse development since a laser exposure device 13 is

used. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a reverse development method, transfer rollers and cleaning blades in the apparatus of U.S. '932 because these are very well known to provide crisp images (laser exposure / reverse development), complete transfer (transfer rollers that press and electrostatically transfer the toner image), and good cleaning (by blades that scrape the surface).

2. Claims 20-21 and 30-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 6 of U.S. Patent No. 6,603,932 in view of Kawabata et al. and further in view of Mizuno.

The combination of U.S. '932 and Kawabata et al. teach everything claimed except the toner being negatively charged and the developer using an AC +DC superposition voltage. Mizuno teach a development device which uses an AC + DC superimposed voltage to transfer negatively charged toner to a photoconductor so as to develop the image. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the development scheme in Mizuno with the U.S. '932 apparatus because an image can be developed in a non-contact manner thus the deposited toner can be prevented from being rubbed off.

2. Applicant's arguments with respect to claims 11-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant added new claims which required the addition of secondary references in the double patenting rejection above.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Beatty whose telephone number is (571) 272-2130. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley, can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

A handwritten signature in black ink, appearing to read 'Robert Beatty', with a long horizontal stroke extending to the right.

Robert Beatty
Primary Examiner
Art Unit 2852

June 23, 2004